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FREDERICK W. GIBB, III
Gibb Intellectual Property Law Firm, LLC
2568-A RIVA ROAD
SUITE 304
ANNAPOLIS, MD 21401

EXAMINER	
CHOI, PETER H	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PATRICK AURRICHIO, WAYNE S. BALTA, AARON H. COBB JR., EDAN T. DIONNE, RAVI S. KUCHIBHOTLA, MITCH E. MEYERS, THOMAS D. MORRIS, CAROLE L. PERRELLO, and GAYLE WOODSIDE

Appeal 2008-5165
Application 09/918,107
Technology Center 3600

Decided: [1] April 9, 2009

Before ANTON W. FETTING, DAVID B. WALKER, and JOSEPH A. FISCHETTI, *Administrative Patent Judges.*

FETTING, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

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[1] The two month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Patrick Aurrichio, Wayne S. Balta, Aaron H. Cobb Jr., Edan T. Dionne, Ravi S. Kuchibhotla, Mitch E. Meyers, Thomas D. Morris, Carole L. Perrello, and Gayle Woodside (Appellants) seek review under 35 U.S.C. § 134 of a final rejection of claims 1-15, 17-26, 28-34, 36-52, 54, and 55, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

We AFFIRM.

The Appellants invented a way that monitors business operations performance against pre-established criteria and provides notification when the performance deviates from such criteria (Specification 1:¶ 0001).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

> 1. A method for monitoring environmental performance information and providing notification when said performance information indicates performance reaching a predetermined level, the method comprising the steps of:
>
> [1] setting performance criteria
>
> to capture performance information at specific times by a predetermined schedule in a system,
>
> wherein said performance criteria is set at one of a global, a regional, and a site-specific level;
>
> [2] accepting a plurality of forms from a plurality of sites at specific times by said predetermined schedule,
>
> each of said forms including instructions, definitions and said performance information according to uniform data definitions;

[3] storing said performance information in a database according to an area of interest of said performance information;

[4] monitoring said performance information for conformance with said performance criteria currently stored;

[5] flagging said performance information

that does not conform with said performance criteria and

generating a report

one of automatically and manually

according to at least a portion of said performance information currently stored;

[6] providing notification when said performance information deviates from said performance criteria;

[7] modifying said performance so that said performance conforms with said performance criteria,

[8] wherein said modifying said performance

is conducted immediately subsequent to said providing notification

when said performance information deviates from said performance criteria

so that said modifying of said performance occurs in real time; and

[9] automatically creating an audit trail to said forms,

wherein said audit trail comprises:

a name of an author;

a creation date;

a name of a modifying user; and,

a date of modification.

This appeal arises from the Examiner's Final Rejection, mailed April 11, 2007. The Appellants filed an Appeal Brief in support of the appeal on October 22, 2007. An Examiner's Answer to the Appeal Brief was mailed on January 8, 2008.

PRIOR ART

The Examiner relies upon the following prior art:

Barrett	US 6,029,144	Feb. 22, 2000
Smalley	US 6,067,549	May 23, 2000
Petke	US 6,163,732	Dec. 19, 2000
Beldock	US 6,490,565 B1	Dec. 3, 2002

REJECTIONS

Claims 1-6, 9-13, 15, 17, 19-24, 28-32, 34, 36, 38-43, 46-50, 52, and 54 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Beldock .

Claims 7, 18, 25, 37, 44, and 55 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Beldock and Petke.

Claims 8, 26, and 45 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Beldock and Barrett.

Claims 14, 33, and 51 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Beldock and Smalley.

ISSUES

The issues pertinent to this appeal are

- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1-6, 9-13, 15, 17, 19-24, 28-32, 34, 36, 38-43, 46-50, 52, and 54 under 35 U.S.C. § 103(a) as unpatentable over Beldock.

- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 7, 18, 25, 37, 44, and 55 under 35 U.S.C. § 103(a) as unpatentable over Beldock and Petke.

- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 8, 26, and 45 under 35 U.S.C. § 103(a) as unpatentable over Beldock and Barrett.

- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 14, 33, and 51 under 35 U.S.C. § 103(a) as unpatentable over Beldock and Smalley.

The pertinent issue turns on whether Beldock's modification occurs immediately subsequent to its notification and whether Beldock's uniform criteria are incompatible with global, regional, and site-specific criteria.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Beldock

01. Beldock is directed to an environmental certification program which defines predefined criteria which must be met by a participant in the program in order to use a certification mark on goods, advertising, press materials, etc. Beldock tracks the compliance by the participant in the environmental certification program, and evaluates the continued certification of a participant in the program. Continued certification requires achieving additional predefined criteria while maintaining the predefined criteria which led to initial certification (Beldock 2:9-24).

02. Beldock provides uniform criteria for participants in the program. As such, the certification mark provided by the program to a complying participant has discernable value in the marketplace (Beldock 2:58-62).

03. Beldock specifies exemplary criteria that must be met to retain certification each year (Beldock 4:30 – 5:31).

04. Beldock describes how based upon participant reporting and on-site verification, it provides an evaluation of compliance by the participant and determines whether the participant is eligible for initial and continued certification in the program. A participant is given a short period of time in which to correct any inadvertent defects in its compliance. Once the participant corrects all aspects of its non-compliance, the participant is once again eligible to use the certification mark (Beldock 5:64 – 6:8).

Facts Related To The Level Of Skill In The Art

05. Neither the Examiner nor the Appellants have addressed the level of ordinary skill in the pertinent arts of systems analysis and programming, performance monitoring systems, automated correction systems, and environmental systems. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) ("[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error 'where the prior art itself reflects an appropriate level and a need for testimony is not shown'") (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

Facts Related To Secondary Considerations

06. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater* , 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369, (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily).

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

Obviousness

A claimed invention is unpatentable if the differences between it and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (2000); *KSR Int'l Co. v. Teleflex Inc*., 127 S.Ct. 1727, 1729-30 (2007); *Graham v. John Deere Co*., 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is bottomed on several basic factual inquiries: "[(1)] the scope and content of the prior art are to be determined; [(2)] differences between the prior art and the claims at issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved." 383 U.S. at 17. *See also KSR*, 127 S.Ct. at 1734. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id*. at 1739.

"When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability." *Id*. at 1740.

"For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *Id.*

"Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *Id.* at 1742.

Automation of a Known Process

It is generally obvious to automate a known manual procedure or mechanical device. Our reviewing court stated in *Leapfrog Enterprises Inc. v. Fisher-Price Inc.*, 485 F.3d 1157 (Fed. Cir. 2007) that one of ordinary skill in the art would have found it obvious to combine an old electromechanical device with electronic circuitry "to update it using modern electronic components in order to gain the commonly understood benefits of such adaptation, such as decreased size, increased reliability, simplified operation, and reduced cost. . . . The combination is thus the adaptation of an old idea or invention . . . using newer technology that is commonly available and understood in the art." *Id* at 1163.

ANALYSIS

Claims 1-6, 9-13, 15, 17, 19-24, 28-32, 34, 36, 38-43, 46-50, 52, and 54 rejected under 35 U.S.C. § 103(a) as unpatentable over Beldock.

Although the arguments section nominally spans Br. 18-55, only Br. 49-55 contains the actual arguments, the remainder being a transcription of the Examiner's rejection. The Appellants argue independent claims 1, 19, and 38 as a group (Br. 49) and rely on those arguments in support of claims 6, 9-13, 15, 17, 24, 28-32, 34, 36, 43, 46-50, 52, and 54 (Br. 55). Accordingly, we select claim 1 as representative of the group. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Examiner found that Beldock generally described the limitations of claim 1. The Examiner further took Official Notice that it is old and well known in the art: (1) to include instructions and definitions along with performance information; (2) for compliance data to be updated to reflect changes in federal, state, and local laws and regulations, program requirements of federal and state-funded programs, and industry standards (such as ISO certification, Quality Control Initiatives, etc.),

as well as self-imposed rules and regulations; (3) that computer operating systems use Master File Tables to store resident attributes for each computer file, including the filename, data, times of creation/modification or access and the user who last created/modified/accessed said file; and (4) to create audit trails of data usage within the system, especially within databases. The Examiner also found that merely providing an automated way to replace a well-known activity which accomplishes the same result is not sufficient to distinguish over the prior art (Answer 4-13).

The Appellants contend that Beldock teaches against modifying the performance immediately subsequent to providing notification when performance information deviates from performance criteria. The Appellants contend that Beldock gives participants a short period of time between notification and modification, which intervenes between those events making the modification not immediately subsequent and not in real time (Br. 49-51). The Appellants further argue that Beldock teaches against setting performance criteria at one of a global, a regional and a site-specific level because Beldock provides uniform criteria which would not vary across regional and site specific levels (Br. 51-52).

The Examiner responds that real time refers to a system that responds to events as they happen. The Examiner found that real time actions are those in which activities match the human perception of time or those in which computer operations proceed at the same rate as a physical or external process and real time computer operations are those in which a computer must respond to situations as they occur. The Examiner further found that Beldock's short period of time is a deadline given to applicants in which to correct any inadvertent defects in its compliance, and is not a time differential between the notification and the modification. This implied that performance modification is conducted subsequent

to receiving notification of non-compliance and thus is in "real time". Further, the Examiner took Official Notice that "real-time updating is old and well known in the art" (Answer 43).

The Examiner further took Official Notice, that it is old and well known in the art for compliance data to be updated to reflect changes in federal, state, and local laws and regulations, program requirements of federal and state-funded programs, and industry standards, as well as self-imposed rules and regulations.

We agree with the Examiner. As to the timing of the modification, the claim requires that modifying performance is conducted immediately subsequent to providing notification when performance information deviates from performance criteria, so that modifying of performance occurs in real time. Beldock evaluates compliance and determines certification eligibility. In doing so, a participant is given a short period of time in which to correct any inadvertent defects in its compliance (FF 04). Thus, the short period of time is that during which defects are corrected, i.e. modified. It is not a period before which such modifications begin as argued by the Appellants. Thus, such modification begins immediately after notification as implied by the short time allotted by Beldock. As the Examiner found, the limitation that modifying of said performance occurring in real time simply means responding with modifications as notification happens. Real time is not given any lexicographic definition in the Specification, but is generally understood as the actual time during which something takes place.[2] This is consistent with Beldock's short period of time for such modifications to occur compared with the period of a year for each phase of Beldock's program (FF 03).

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[2] Merriam Webster On-Line Dictionary
http://www.merriam-webster.com/dictionary/real+time

As to the argument that Beldock teaches away from performance criteria set at one of a global, a regional and a site-specific level, again we disagree. Beldock provides uniform criteria for participants in the program for the purpose of giving its certification mark discernable value in the marketplace (FF 02). Thus, the criteria must be such that it responds to the market requirements.

As the Examiner found, such criteria must reflect federal, state, and local laws and regulations, program requirements of federal and state-funded programs, and industry standards, as well as self-imposed rules and regulations. There is nothing inherently contradictory between criteria that are uniform and consistent with this variety of laws and regulations.

The Appellants appear to imply that uniformity implies being fixed, static and constant. However uniformity only means that the measurement process itself is consistent, not that the standard against that which something is measured is fixed. The standard for environmental results would be appropriately measured uniformly relative to the applicable national and local laws.

The Appellants separately argue method claims 2-5 and their corresponding system and software claims 20-23 and 39-42. All of the arguments are presented with respect to the limitation in claim 2 that the criteria include site specific performance criteria. Thus, the Appellants are arguing that Beldock's uniform criteria cannot meet this limitation as they did in claim 1. We find this argument equally unpersuasive here for the same reason as in claim 1.

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 1-6, 9-13, 15, 17, 19-24, 28-32, 34, 36, 38-43, 46-50, 52, and 54 under 35 U.S.C. § 103(a) as unpatentable over Beldock.

Claims 7, 18, 25, 37, 44, and 55 rejected under 35 U.S.C. § 103(a) as unpatentable over Beldock and Petke.

Although the arguments section nominally spans Br. 55-58, only Br. 58 contains the actual arguments, the remainder being a transcription of the Examiner's rejection. The Appellants argue these claims on the basis of the patentability of the independent claims, which we found unpersuasive *supra*. The Appellants have accordingly not sustained their burden of showing that the Examiner erred in rejecting claims 7, 18, 25, 37, 44, and 55 under 35 U.S.C. § 103(a) as unpatentable over Beldock and Petke.

Claims 8, 26, and 45 rejected under 35 U.S.C. § 103(a) as unpatentable over Beldock and Barrett.

Although the arguments section nominally spans Br. 58-61, only Br. 61 contains the actual arguments, the remainder being a transcription of the Examiner's rejection. The Appellants argue these claims on the basis of the patentability of the independent claims, which we found unpersuasive *supra*. The Appellants have accordingly not sustained their burden of showing that the Examiner erred in rejecting claims 8, 26, and 45 under 35 U.S.C. § 103(a) as unpatentable over Beldock and Barrett.

Claims 14, 33, and 51 rejected under 35 U.S.C. § 103(a) as unpatentable over Beldock and Smalley.

Although the arguments section nominally spans Br. 61-63, only Br. 63 contains the actual arguments, the remainder being a transcription of the Examiner's rejection. The Appellants argue these claims on the basis of the patentability of the independent claims, which we found unpersuasive *supra*. The Appellants have accordingly not sustained their burden of showing that the

Examiner erred in rejecting claims 14, 33, and 51 under 35 U.S.C. § 103(a) as unpatentable over Beldock and Smalley.

CONCLUSIONS OF LAW

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 1-15, 17-26, 28-34, 36-52, 54, and 55 under 35 U.S.C. § 103(a) as unpatentable over the prior art.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 1-6, 9-13, 15, 17, 19-24, 28-32, 34, 36, 38-43, 46-50, 52, and 54 under 35 U.S.C. § 103(a) as unpatentable over Beldock is sustained.
- The rejection of claims 7, 18, 25, 37, 44, and 55 under 35 U.S.C. § 103(a) as unpatentable over Beldock and Petke is sustained.
- The rejection of claims 8, 26, and 45 under 35 U.S.C. § 103(a) as unpatentable over Beldock and Barrett is sustained.
- The rejection of claims 14, 33, and 51 under 35 U.S.C. § 103(a) as unpatentable over Beldock and Smalley is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

LV:

FREDERICK W. GIBB, III
Gibb Intellectual Property Law Firm, LLC
2568-A RIVA ROAD
SUITE 304
ANNAPOLIS, MD 21401